

newspaper page. Claim 1 further recites that each of the first and second plate cylinders carries four flexible printing plates. Claim 1 further recites that the flexible printing plates are wrapped around the cylinders and are held by a plate lock-up mechanism, wherein the flexible printing plates are mounted on the first and second plate cylinders side by side. Claim 1 further recites that each of the first and second blanket cylinders have substantially the same diameter as the associated plate cylinder. Claim 1 further recites that each of the first and second blanket cylinders are cantilevered in the first side wall of the housing, when removing the continuous blanket sleeves from the first and second blanket cylinders. Claim 1 further recites that the length to diameter ratio of the first and second plate cylinders is in the range between 5.8 : 1 and 9 : 1.

The Office Action alleges that Smith teaches a plate cylinder four pages wide and having four pages across, wherein each plate is the size of a page. The Office Action further alleges that Harenza teaches a plate cylinder having four plates across and one plate around. The Office Action further alleges that Guaraldi et al. disclose a housing, sidewalls, first and second plate cylinders each having a plate lock-up mechanism, and first and second blanket cylinders each having an axially removable continuous blanket. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to utilize the plate cylinder of Smith, as modified by Harenza, in the press of Guaraldi et al. to achieve well known benefits of blanket sleeves such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced. Applicants respectfully disagree for the reasons set forth below.

Smith purportedly relates to a dampener for a printing press. Title. Smith states that the printing press includes a plate cylinder 10 adapted to carry four axially adjacent lithographic printing plates mounted about the peripheral surface thereof. See col. 2, lines 11 to 17. Nowhere does Smith disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Applicants note that there is a distinction between a "plate" and a "page". A one-around cylinder mounted plate may have more than one page mounted around its circumference depending on its height. Accordingly, disclosure by Smith of a one around plate in no way discloses, or even suggests, having the height of the plate sized to fit only one newspaper page, as

recited in claim 1. Therefore, Smith does not disclose all of the limitations of claim 1.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." See M.P.E.P. § 2112 (emphasis in original); and see, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The Office Action refers to the sentence bridging columns 1 and 2, column 2, lines 11 to 17 and column 3, lines 39 to 56 and alleges that Smith teaches a plate cylinder four pages wide and having four pages across, wherein each plate is the size of a page. Applicants respectfully disagree and submit that nowhere does Smith state that each plate is the size of a page, let alone does Smith state that each plate has the height of a newspaper page. Further, nowhere does Smith state how many pages can fit on a single plate. Applicants submit that it is common in magazine and brochure production to place the entire content of, for example, 12, 16, or 24 pages down on a single plate. As indicated above, Smith does not indicate the size of the plate, let alone that each plate has the height of a single newspaper page. Furthermore, as detailed below, nor would it have been obvious to one skilled in the art to reduce the size of the cylinders so as to receive a plate having the height of a single newspaper page given the expected increase of vibrations resulting from a decrease in diameter of the cylinders.

Harenza purportedly relates to a printing press including a means for securing and registering thin printing plates on a cylinder driven in either direction. See col. 1, lines 9 to 12. The cylinder is stated to have a plate mounted "one around" and either two or four plates across extending the length of the cylinder. See col. 2, lines 34 to 38. Nowhere does Harenza disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Therefore, Harenza does not disclose all of the limitations of claim 1. The Office Action alleges that Harenza teaches a plate cylinder having four plates across and one plate around. However, the Office Action does not even allege that Harenza discloses plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1.

Guaraldi et al. purportedly relates to a printing unit. Abstract. Guaraldi et al. state that the printing unit includes upper and lower plate cylinders 14 and 18. A single printing plate is stated to be wrapped around each plate cylinder by locking mechanisms. See col. 2, lines 49 to 53. Nowhere do Guaraldi et al. disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Therefore, Guaraldi et al. does not disclose all of the limitations of claim 1.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Since the neither Smith, Harenza nor Guaraldi et al. disclose, or even suggest, all of the limitations of claim 1, including a plate cylinder having a circumference substantially equal to the height of a single newspaper page, it is respectfully submitted that the combination of Smith, Harenza and Guaraldi et al. does not render obvious claim 1.

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight**

**reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed

limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

The Office Action alleges that it would have been obvious to one of ordinary skill in the art to utilize the plate cylinder of Smith, as modified by Harenza, in the press of Guaraldi et al. to achieve well known benefits of blanket sleeves such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced. See Office Action at pp. 4 to 5. Applicants respectfully disagree.

As indicated above, Smith states that the printing press includes a plate cylinder 10 adapted to carry four axially adjacent lithographic printing plates mounted about the peripheral surface thereof. See col. 2, lines 11 to 17. Smith does not disclose, or even suggest, a blanket cylinder, let alone the relative size of the plate and blanket cylinders. Given the time frame of Smith, however, it is known that blanket cylinders were clamped at their ends in relatively large grooves in the blanket cylinder, which required a 2:1 blanket cylinder to plate cylinders diameter ratio to dampen vibrations.

Harenza also does not directly disclose a blanket cylinder or the relative size of the blanket cylinder to the plate cylinder. However, a large vibration causing gap, required by the use of the two lock-up mechanism (see Figure 8), indicates that the blanket cylinders used with the plate cylinders generally would have a 2:1 diameter ratio. The larger blanket cylinders being used to dampen vibrations caused by the large gap in the plate cylinder.

Given the above, one skilled in the art would recognize that Smith and Harenza deal with 2:1 printing presses. Applicants submit that it would not have been obvious to take a plate cylinder used in a 2:1 printing press, such as Smith and Harenza, as suggested by the Office Action, and use it in a 1:1 printing press, such as Guaraldi et al. The relative size of the plate and blanket cylinders has a dramatic

effect on the vibrations produced and thus the overall functioning of the printing press. Accordingly, the plate and blanket cylinders are necessarily designed as pairs. Given this design reality it would not have been obvious to mix and match pair elements, i.e., take the plate cylinder alone from the 2:1 printing press of Smith or Harenza and use it to replace the plate cylinder from the 1:1 printing press of Guaraldi, even if it was obvious (which Applicants do not admit) to widen the Guaraldi plate cylinder from one plate wide to four plates wide in light of Smith or Harenza. 3

The Office Action alleges that Guaraldi et al. teach continuous blanket cylinders. Applicants submit that even given the existence of the continuous, and thus gapless, blanket of Guaraldi it would not have been obvious to use a 1:1 plate cylinder and blanket cylinder, pair, wherein the plates mounted on the plate cylinder have a height of a single newspaper page, as recited in claim 1. Assignee Heidelberg's own relevant product in this area prior to the filing date, the Galaxy newspaper press, was a 1:1 press with a four-across two-around plate cylinder. One skilled in the art, however, would not have found it obvious to have reduced the diameter of the plate cylinder from two-around to one-around, as claimed in claim 1, given the expected increase in vibrations and decrease in cylinder stiffness, which are both undesirable side effects. Applicants have discovered, however, that when the plate and blanket cylinders have a 1:1 diameter ratio the cylinders have a thinner line of contact which results in an increase in nip pressure and allows for reduced diameters without increased vibration. Therefore, Applicants submit that claim 1 is patentable over the combination of Smith, Harenza and Guaraldi et al. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 1.

As for claims 2, 5, 6, and 11, which depend on claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that the combination of Smith, Harenza and Guaraldi does not render obvious these claims for at least the same reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 2, 5, 6 and 11.

### III. Rejection of Claims 3 and 4 Under 35 U.S.C. §103(a)

Claims 3 and 4 were rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and U.S. Patent No. 5,481,971 ("Grutzmacher et al."). Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and Grutzmacher et al. does not render obvious claims 3 and 4 for the following reasons.

Applicants submit that Grutzmahcer et al. do not cure the deficiencies of Smith or Harenza. Specifically, Grutzmacher et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claims 3 and 4 depend from claim 1 and therefore include all of the limitations of claim 1. Accordingly, Applicants submit that claims 3 and 4 are patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 3 and 4.

Regarding claim 3, Applicants submit the following additional reasons in support of patentability. Claim 3 depends from claim 1 and further recites that the plate cylinders and their associated blanket cylinders form printing couples, and each of said printing couples is driven by a separate motor.

Grutzmacher et al. purportedly relates to a printing press including multiple printing units. Abstract. The printing units are stated to each have separate drive motors. Abstract. Applicants submit that nowhere does Grutzmacher et al. disclose, or even suggest, plate cylinders and their associated blanket cylinders in a single printing unit forming printing couples, and each of said printing couples driven by a separate motor, as recited in claim 3. Therefore, Applicants submit that the combination of Smith, Harenza, Guaraldi et al. and Grutzmacher et al. does not render obvious claim 3. ?

### IV. Rejection of Claim 7 Under 35 U.S.C. §103(a)

Claim 7 was rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and U.S. Patent No. 5,152,222 ("Okamura et al."). Applicants respectfully submit that the combination of Smith,

Harenza, Guaraldi et al. and Okamura et al. does not render obvious claim 7 for the following reasons.

Applicants submit that Okamura et al. do not cure the deficiencies of Smith, Harenza and Guaraldi et al. Specifically, Okamura et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claim 7 depends upon claim 1 and therefore includes all of the limitations of claim 1. Accordingly, Applicants submit that claim 7 is patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 7.

**V. Rejection of Claims 8 to 10 Under 35 U.S.C. §103(a)**

Claims 8 to 10 were rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al., Okamura et al. and U.S. Patent No. 5,481,971 ("Andersson et al."). Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and Andersson et al. does not render obvious claims 8 to 10 for the following reasons.

Applicants submit that Andersson et al. do not cure the deficiencies of Smith, Harenza, Guaraldi et al. and Okamura et al. Specifically, Andersson et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claims 8 to 10 ultimately depend upon claim 1 and therefore include all of the limitations of claim 1. Accordingly, Applicants submit that claims 8 to 10 are patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 8 to 10.

Regarding claim 9, Applicants submit the following additional arguments in support of patentability. Claim 9 depends upon claim 8. Claim 8 depends on claim 1 and further recites that a fifth printing unit is arranged on top of the four printing units. Claim 9 further recites that the four printing units are for



printing the colors yellow, magenta, cyan and black and said fifth printing unit is printing spot-colors which are different from said colors of said four printing units.

The Office Action refers to column 1, lines 63 to 67 and alleges that Andersson et al. discloses a fifth printing unit. The Office Action further alleges that it would have been obvious to one of ordinary skill in the art to utilize the fifth printing unit for printing any additional or same color, spot color or even lacquer. See Office Action at p.6. Applicants respectfully disagree. Nowhere in the portion of Andersson et al. referenced is there any disclosure, or even suggestion, of the specific use of the fifth printing unit for printing spot-colors which are different from the colors of the four other printing units, as recited in claim 9. Nor is there any motivation or suggestion provided by Andersson et al. to use a fifth printing unit in this specific manner. Therefore, Andersson et al. do not cure the deficiencies of Smith, Harenza, Guaraldi et al. and Okamura et al. \*

Regarding claim 10, Applicants submit the following additional arguments in support of patentability. Claim 10 depends upon claim 9 and further recites that the fifth printing unit prints the same color as one of said four other printing units and is operated in alternation with said printing unit printing the same color. Nowhere does Andersson et al. disclose, or even suggest, that the fifth printing unit has a different color than one of the four other printing units and is operated in alternation with the other printing unit. Nor is there any motivation provided, or even suggested, to use a fifth printing unit in this specific manner. Therefore, Andersson et al. do not cure the deficiencies of Smith, Harenza, Guaraldi et al. and Okamura et al. \*

#### **VI. Rejection of Claim 12 Under 35 U.S.C. §103(a)**

Claim 12 was rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and "applicant's admission of prior art". Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al., Andersson et al. and "applicant's admission of prior art" does not render obvious claims 8 to 10 for the following reasons.

As an initial matter, in addressing the merits of this rejection, Applicants do not concede the correctness of the Office Action's characterization of the subject matter on page 4 of the Specification as prior art, but will proceed, for the sake of argument only, on the premise that the Office Action's characterization is

accurate. Therefore, when framed accordingly, Applicants' argument is that even if the Office Action is correct in characterizing page 4 of the Specification as prior art, the invention of claim 12 would still be patentable over such alleged admitted prior art.

Applicants submit that the admitted prior art does not cure the deficiencies of Smith, Harenza and Guaraldi et al. Specifically, the admitted prior art does not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claim 12 depends from claim 1 and therefore includes all of the limitations of claim 1. Accordingly, Applicants submit that claim 12 is patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 12

#### **VII. Nonstatutory Double Patenting Rejection of Claims 1 to 12**

Claims 1 to 12 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 12 of U.S. Patent No. 6,374,731. The Office Action indicates, however, that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome this rejection. Applicants will prepare a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the nonstatutory double patenting rejections of claims 1 to 12 upon withdrawal of all rejections and when the claims are indicated to be in final form for allowance. Accordingly, an indication that all of the pending claims are allowable post filing of the terminal disclaimer is respectfully requested.

**VIII. New Claims 13 and 14**

New claims 13 and 14 have been added herein. It is respectfully submitted that new claims 13 and 14 do not add any new matter and are fully supported by the present application, including the Specification. It is respectfully submitted that claims 13 and 14 are allowable.

**IX. Conclusion**

It is therefore respectfully submitted that the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the Specification and claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

Respectfully submitted,

KENYON & KENYON

Dated: 5/28/03

By: 

Abraham Ronai  
Reg. No. 41,275  
One Broadway  
New York, New York 10004  
(212) 908 - 6408

**CUSTOMER NO. 26646**



**26646**

PATENT TRADEMARK OFFICE

Serial No. 10/087,568

Version with Markings to Show Changes Made

**IN THE SPECIFICATION:**

The section captioned "**ABSTRACT**" has been amended as follows:

--A lithographic newspaper printing press including [comprises] printing units which are mounted on top of each other, forming a tower arrangement. Each printing unit including [comprises] a first and a second plate cylinder having a length being substantially four times the width of a newspaper page and having a circumference being substantially equal to the height of a newspaper page. Each printing unit further includes [comprises] a first and a second blanket cylinder associated with said first and second plate cylinders, whereby each of said first and second blanket cylinders has substantially the same diameter as the associated plate cylinder. Each of the blanket cylinders carries a respective continuous sleeve-shaped printing blanket which is axially removable from the respective plate cylinder through an aperture formed in the side wall of the housing of the printing unit, while the respective blanket cylinder is cantilevered in the opposite side wall of the housing.--.

**IN THE CLAIMS:**

New claims 13 and 14 have been added.